

IN SENATE
Supreme Court of the United States

October Term, 1943.

No. 1042

**LINE MATERIAL COMPANY AND WILLIAM O.
SCHULTE,**

Petitioners,

vs.

CASPER W. GOME, COMMISSIONER OF PATENTS,

Respondent.

**SECOND PETITION OF LINE MATERIAL COMPANY
AND WILLIAM O. SCHULTE FOR A WRIT OF
CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE DISTRICT OF COLUMBIA.**

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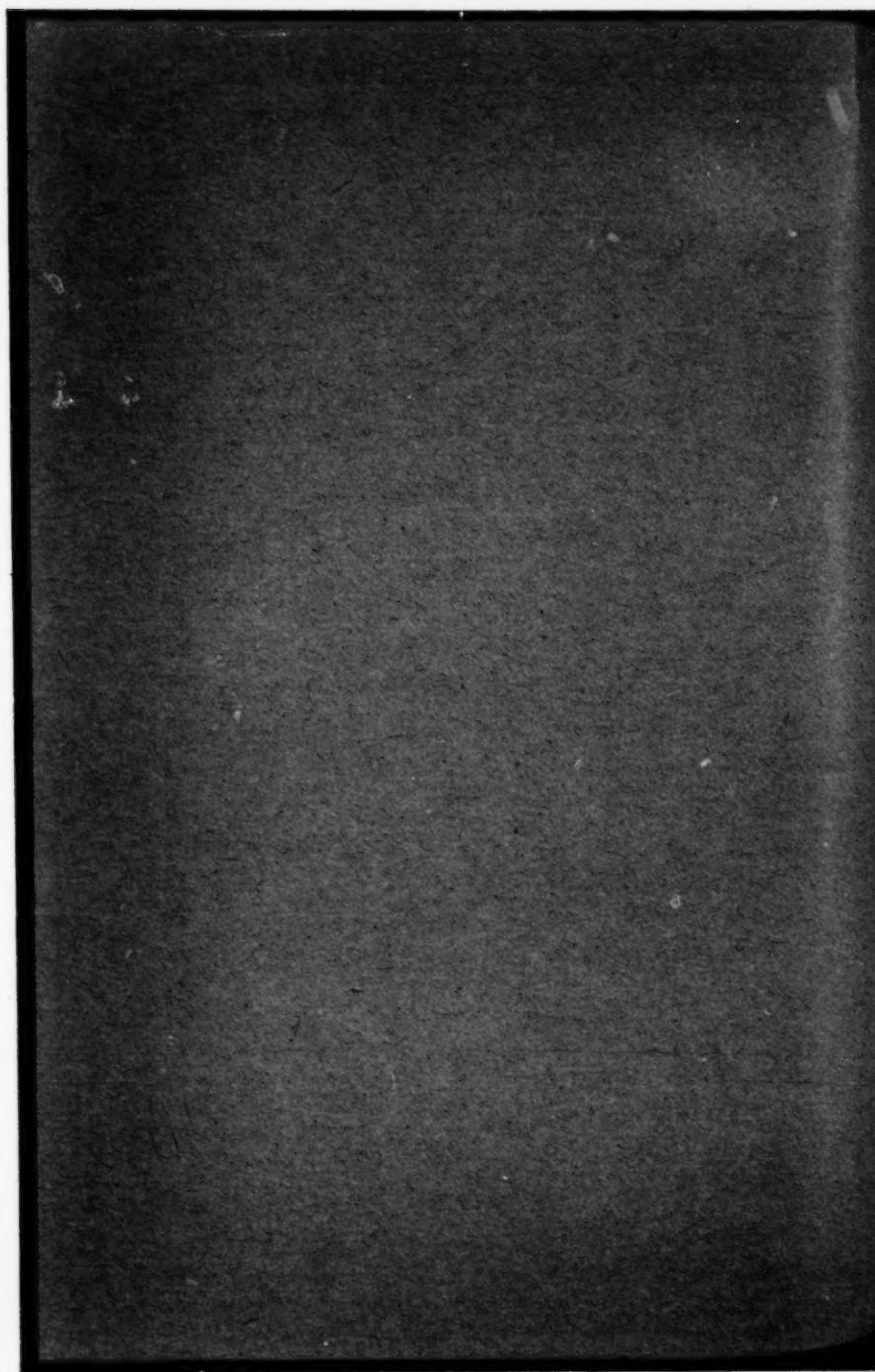
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Dated: Chicago, Illinois,

March 25, 1944.



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Your petitioners, Line Material Company and William O. Schultz, respectfully pray for a writ of certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that court entered on the 17th day of December, 1945,¹ (petition for rehearing denied January 7, 1946).² A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

1. Rec. p. 136.

2. Rec. p. 140.

This is the Second Petition to this Court filed by your petitioners in the above entitled cause; the first petition, which was not opposed by the defendant, having been granted by this Court on May 7, 1945.³ In the first petition your petitioners raised the same point as is here presented in addition to a question of jurisdiction not herein involved.

Jurisdiction.

The basis upon which it is contended that this Court has jurisdiction to review the judgment in question is:

1. The judgment was rendered in a civil action brought under the patent statutes to secure an adjudication that the petitioners are entitled, according to law, to receive a patent for the invention as specified in Claims 46, 48 and 49 of a pending application for patent.

2. The judgment to be reviewed is the District Court's judgment of January 18, 1943,⁴ affirmed by the Court of Appeals on December 17, 1945⁵; petition for rehearing having been denied on January 7, 1946.⁶

3. The Courts below have decided a question of general importance and of substance relating to the construction or application of Sec. 4915 of the Revised Statutes 35 U. S. C. A. 63, which although not specifically settled by this Court has been decided in such a manner as to contravene the principles of law recently announced by the Supreme Court in the case of **Special Equipment Co. vs. Coe** 65 SC 741 wherein the Supreme Court reversed the present Circuit Court of Appeals on an analogous question in a suit under Sec. 4915 R.S.

3. Rec. p. 133.

4. Rec. p. 16.

5. Rec. p. 136.

6. Rec. p. 140.

4. The statute under which jurisdiction is invoked is 240 (a) of the Judicial Code, 28 U.S.C.A. 347, as amended, by the Act of February 13, 1925.

5. Cases believed to sustain jurisdiction are:

Special Equipment Co. v. Coe, 65 SC 741.

Hoover v. Coe, 325 U.S. 79

Line Material v. Coe, 65 U.S.P.Q. 237, Decided by this Court on May 7, 1945.

Questions Presented.

The questions, which involve the construction of the Constitution and Patent Laws enacted pursuant to the Constitution, are:

1. Whether, as the Court of Appeals of the District of Columbia held, an applicant for letters patent may properly be refused his remedy under Section 4915 on the independent conclusion of the Court that the mechanical structure involved in the claims sought was not shown to be clearly and positively necessary? This question corresponds substantially with Question 3 of your petitioners' previous Petition granted by this Court; and is of the same general character as was passed upon by this Court in the recent special equipment case where the present Court of Appeals was reversed for conditioning a patent grant on a showing of use of the invention.

More specifically stated, where the Court finds that in an applicant's structure, a fuse tube is biased downwardly thereby contributing to the releasing of a latch called for in the claims sought should claims on such structure be denied solely on the Court's own independent conclusion that the force flowing from the movement of the fuse tube was gratuitous and not imperative to the unlatching operation? That is to say, is it a prerequisite to a patent, on an

otherwise admittedly patentable structure, that the applicant establish that a particular element or feature of the structure claimed is indispensable in the use of the structure?

2. Where in a suit under Section 4915 the plaintiffs sustained their burden of proof by showing through uncontroverted testimony of a man found to be highly skilled in the art that the fuse structure of the claims on which a patent is sought is inherent in the disclosure of the application, and as established by uncontroverted models, may a Federal Court in the absence of any testimony on the part of the defendant Commissioner of Patents, other than the unsworn to actions of the Patent Office Examiners, who were not made available for cross-examination, properly refuse such claims solely because the Court concluded that certain features of the claimed fuse structure were not shown to be necessary for the operation of the same?

Summary and Short Statement of the Matter Involved.

1. On May 24, 1934, petitioner, William O. Schultz, filed an application for a patent for an electrical fuse construction which received Serial No. 727,450,⁷ and which was assigned to petitioner, Line Material Company.⁸

2. Petitioners sought a patent on this application to cover the invention thereof as defined in claims 46, 48 and 49 of said application.⁹

3. On March 11, 1942, the Board of Appeals refused a patent on this application as to these claims, ruling that such claims were not supported by the disclosure in the

7. Rec. p. 3, par. 6.

8. Rec. p. 3, par. 7.

9. Rec. p. 3, par. 9.

application.¹⁰ Such claims are conceded by the Patent Office to be patentable.

4. Petitioners did not take an appeal to the United States Court of Customs and Patent Appeals but exercised the alternative remedy provided for by Section 4915 of the revised Statutes (U.S.C. Title 35, Sec. 63)¹¹ by filing thereunder, on August 3, 1942, a timely bill in equity in the United States District Court for the District of Columbia.¹²

5. The defendant below admitted in its answer that your petitioner, William O. Schultz, is the first inventor of the inventions disclosed in his application and was the senior party in a previously terminated Patent Office interference proceeding.¹³

6. A trial was had on the merits, the defendant offering no evidence other than the Patent Office record, and, on January 18, 1943, the District Court entered judgment (40 Fed. Sup. 633) on the merits and dismissed petitioners' complaint,¹⁴ from which, on February 16, 1943, an appeal was taken to the United States Court of Appeals for the District of Columbia.¹⁵

7. The Court of Appeals in a decision 144 Fed. (2) 518 dated July 10, 1944,¹⁶ under the authority of *Hoover v. Coe* 144 Fed. (2) 514, decided the same date, affirmed the Lower Court's dismissal of the complaint.

8. A petition for writ of certiorari was then filed, **which**

10. Rec. pp. 122-124.

11. Rec. p. 7, par. 24.

12. Rec. p. 2.

13. Rec. p. 9. The complaint so alleged (Pars. 5, 6 and 10; Rec. pp. 2, 3 and 4). These allegations were admitted (Ans. par. 1, Rec. p. 9).

14. Rec. p. 16.

15. Rec. p. 17.

16. Rec. p. 129.

was not opposed by defendant, and this Court on May 7, 1945, granted the petition, 65 Sup. Court 1182, and reversed the judgment and remanded the cause to the United States Court of Appeals for the District of Columbia for further proceedings. In that petition your petitioners in the first two questions presented raised the matter of jurisdiction and in the third question raised a question that is submitted in the present Second Petition for Writ of Certiorari.

9. The Court of Appeals on July 5, 1945,¹⁷ entered an order recalling its mandate of August 17, 1944, and on October 8, 1945, entered an order setting the case down for hearing on October 27, 1945. On December 17, 1945, the Court of Appeals rendered a new decision 152 F (2) 665¹⁸ on the merits and affirmed the Lower Court's judgment dismissing the Bill of Complaint.¹⁹

Your petitioners thereupon filed with the Court of Appeals a petition for re-hearing under Rule 26, which petition was denied by the Court of Appeals on January 7, 1946.²⁰

10. The material facts with respect to this application upon which the Lower Court sustained the Patent Office in its refusal to grant the applicant a patent with Claims 46, 48 and 49 of said application are as follows:

(a) **There is no question of the patentability of these claims involved in the case.**²¹ The issue is whether or not your petitioners, by reason of the original Schultz application and inherent operation of the fuse therein disclosed are entitled to these three claims directed to a

17. Rec. p. 134.

18. Rec. p. 136.

19. Rec. p. 139.

20. Rec. p. 140.

21. Rec. p. 137.

fuse cooperating with latch means in the release of the latter.

(b) In the trial below, your petitioners, to meet the issue presented by the Patent Office's decision, presented testimony²² of one skilled in the art together with models of the devices of the application; and the Lower Courts notwithstanding the fact that the Commissioner did not offer any testimony to refute that of the plaintiffs ruled against plaintiffs. In making this ruling the District Court made a Finding of Fact²³ to the effect that "The evidence shows that plaintiffs' expert witness, as one man skilled in the art and perhaps exceptionally so, did construct models wherein the springs coiled about the fuse tube, presumably did expedite, to some degree, the consummation of the unlatching process. * * *"

The District Court made a further Finding²⁴ reading **"Granting, however, that such operation might be held to be inherent in the fuse structures** illustrated by Figures 1, 4 and 5 of the application drawings and in the unquestioned models which were demonstrated by plaintiffs' witness, a man skilled in the art, who testified that these springs must function in order that a final release of the latch may be effected, it is held that to permit plaintiffs to claim a fuse with such operation as in Claims 46, 48 and 49 and to amend the specification to cure the deficiencies, would result in new matter being introduced in the application."

11. The Court of Appeals in its decision of December 17, 1945,²⁵ on the merits properly ruled with respect to the foregoing matter that under the established practice ap-

22. Rec. pp. 32 to 80.

23. Rec. p. 14.

24. Rec. p. 16.

25. Rec. p. 136.

proved by the Courts **an applicant for patent should not "be denied the inherent concomitants of his invention even in the presence of a description that is inconsistent with the fact of operation"**²⁶ and that that was "particularly true, where, as here, the language used appears to be primarily directed toward describing a mechanical arrangement of parts rather than the functioning of the device." The Court in this regard cited with approval *Ellis v. Shaw*, 295 Fed. 1006 and *Prescott et al. v. Swain*, 39 Fed. (2) 241, which were relied upon by plaintiffs.

The Court of Appeals, however, still affirmed the Judgment, **dismissing the Bill, on its own independent conclusion that** while "the fuse tube in biasing downward possibly contributes to the releasing action" **such force was not shown to be necessary** and hence the applicant was not entitled to the claims.

Reasons for Granting the Writ.

1. The decision of the Court of Appeals in this case is in direct conflict with and contrary to the Constitution and the patent statutes, enacted pursuant thereto, and the uniform decisions of this and all other United States Courts and including the recent decision in the case of **Special Equipment Co. v. Coe**, 65 S.C. 741 wherein this Court reversed the present Court of Appeals on much the same type of question although not identical, as is here presented.

2. The decision of the Court of Appeals refuses admittedly patentable claims in a suit under Sec. 4915 R.S. (35 U.S.C.A. 63) solely because the Court concluded that a certain feature of the claims found to be inherently present in the applicant's disclosed structure **was not shown to be necessary, or in other words, indispensable.**

26. Rec. p. 138.

3. The decision of the Court below contravenes the spirit and intent of the Constitution especially since Congress, in the choice of means of promoting the useful arts by patent grants, did not in any way condition such grant on a showing of the necessity for a useful and novel feature of a claim found upon due examination by the Patent Office to embrace patentable subject-matter.

4. In the Special Equipment case (*Supra*) this Court found the Court of Appeals for the District of Columbia to be in error in independently concluding that a grant of patent is **conditioned on a showing of use** of the invention. The Circuit Court here indulged in a similar error, but on a slightly different premise, namely, that of conditioning the patent grant on a showing of necessity or indispensability of the invention notwithstanding the complete absence of any legal authority, either in the decisions or statutes, for making such a condition a prerequisite to a patent.

5. The decision below, if not reversed, creates and applies a bar which very substantially impairs the patent system and which, if followed by the Patent Office and Courts, would unduly complicate the issuance and construction of patents in a manner not in any way contemplated by the patent laws promulgated by Congress. Therefore, there is here a question of *tremendous public importance*, not only throughout this land, but all foreign countries accorded reciprocity privileges regarding patents here.

6. The Court of Appeals' decision if allowed to stand negatives the remedy afforded applicants for Letters Patent by Sec. 4915 of the R. S. and denies an applicant his statutory right under Section 4886 of the Revised Statutes, 35 U.S.C.A. 31, which authorizes "any person who has invented * * * any new and useful * * * machine to obtain a patent."

7. Furthermore, the adverse ruling of the Court of Appeals, in the absence of any testimony at all by the defendant, other than the unsworn to actions in the Patent Office Record, is contrary to the previous decisions of the Court of Appeals of the District of Columbia, such as in the cases of *Ellis v. Shaw*, 295 Fed. 1906 and *Prescott et al. v. Swain* 39 F. (2) 241. The plaintiffs have established by unrefuted testimony of a witness skilled in the art that the subject-matter of the claims in suit is inherent in the disclosure of the application of the plaintiffs and under the established practice of the aforesaid decisions in suits, under Section 4915 R.S. the plaintiffs should have been granted the claims sought.

8. This Court previously granted your petitioners first petition for writ of certiorari in which among the questions raised was one of merits also presented by this Second Petition. This Court in its *Per Curiam* decision stated that the judgment of the Court below was reversed on the authority of *Hoover Company v. Coe*, decided April 3, 1945, (*supra*) which, it is true, had to do with the question of jurisdiction and did not specifically refer to the question of merits here raised. Hence this Court should grant this petition so as to settle this question which involves the very essence of our Patent system.

9. In making a ruling that the plaintiffs had made no showing of necessity for the feature of the invention in issue, even assuming that the same was a requirement to the grant of a patent, since the patent application itself on the very first page thereof, in the statement of the objectives specifically states that **the biasing of the tube aids in quickly extinguishing the arc upon blowing of the fuse.** The testimony of Mr. McNulty, who was found to be highly skilled in the art, also substantiates this showing.

Wherefore, your petitioners respectfully pray that a

writ of certiorari issue out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding said court to certify and send to this Court, on a date to be designated, a full transcript of the record and full proceedings had in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby as well as to the question of whether petitioners are entitled, according to law, to receive a patent for their said invention, and that the judgment of the courts below be reversed, and that these petitioners may be granted such other and further relief as may seem proper.

Respectfully submitted,

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WILLIAM A. SMITH, JR.

Of Counsel.

Dated: Chicago, Illinois,

March 26, 1946.